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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,107	01/12/2001	Elliott D. Light	2344-001-CIP2	1835

7590 06/08/2004

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EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,107

Applicant(s)

LIGHT ET AL.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-16,30-44 and 52-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29,45-48 and 50 is/are rejected.
- 7) ☒ Claim(s) 49, 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 17-29 and 45-51 (group II) in Paper No. 6 filed 4/26/2004 is acknowledged.
2. Claims 1-16, 30-44 and 52-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.
3. This application contains claims drawn to an invention nonelected without traverse in Paper No. 6. A complete reply to any final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

5. The disclosure is objected to because of the following informalities: The specification contains numbering of each paragraph therein, this may cause confusion in printing should the application be allowed.

Appropriate correction is requested.

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Claim Rejections - 35 USC § 112

6. Claims 17-29, 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, on (ln.6) reference is made to “a message creation device creates an alphanumeric message” which is confusing and may be inaccurate of the disclosed invention as it was understood that a person would create the message using the device but not that a device creates without user input as the claim is written. For examination purposes it is assumed the intent is to have a person create the message using the device.

Similar confusion arises in claim 46.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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8. Claims 17-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Huna (#6,438,217).

The claims read on Huna as follows: Huna teaches (col.14,ln.38-col.15,ln.38) as pertains to claim 17, system for communicating over network which includes voice mail converter (message server 402) which converts alphanumeric (textual) message to voice mail message and enables called party to access (receive) the voice mail message which has been sent from an originating terminal (message creation device), which enables a sender to create the message thereat for sending over the network for conversion into voice mail by the voice mail converter (col.17,ln.1-11; col.17,ln.50-53) . With respect to claim 18, the network is a wireless network (figure 5) teaches use of pager and (col.1,ln.45-49) teaches the telephony-centric network includes a network that carries telephony information such as voice...page messages...to facilitate information exchange among telephony devices and (col.1,ln.53-58) teaches telecommunications device includes POTS telephone, cellular telephone, PDA, video telephone, thus any telephone which can dial a telephone number and connect to the defined telephony-centric network of the invention including wireless is taught by Huna and as applies to claims 18-29.

9. Claims 45, 47, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Bannister et al. (#5,943,399)

The claims read on Bannister as follows: Bannister teaches (col.5,ln.11-30) Bannister teaches system with telephone status monitor (MSC/HLR/VLR) monitoring plurality of wireless terminals and status file (service node 500 receives from the MSC/HLR/VLR) via Gateway MSC 600, the file is accessible to the inquiring computer (workstation 100).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 46 and 48 rejected under 35 U.S.C. 103(a) as being unpatentable over Bannister as applied to claims 45 and 47 above in view of Shaughnessy et al. (#5,928,325).

Bannister teaches that which is as applied above to claims 45 and 47 respectively.

With respect to claims 46 and 48 Bannister does not teach the creating of alphanumeric message and sending to the called party via voice mail conversion.

Shaughnessy teaches (col.1,ln.30-35; col.3,ln.20-36; col.4,ln.3-14; col.4,ln.38-57; col.4,ln.65-col.5,ln.29; col.7,ln.36-62; col.8,ln.51-col.9,ln.12) a system for communicating status of wireless devices such as to enable a user (65 figure 1) to send a textual message to central server (15) which determines using status of the wireless devices of the recipient the format and destination of the message, with text to voice conversion performed in (content transformer 20),

It would have been obvious to one of ordinary skill in the art at the time the inventions was made to modify Bannister to perform the conversions of text to voice as taught by Shaughnessy for the purpose of enabling the user of Bannister to send text messages to a non text enabled terminal in voice form so that the recipient could receive the message when they were at a non-text enabled terminal.

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Conclusion

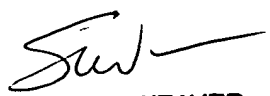
12. Claims 49 and 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Tuesday to Friday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645